

REMARKS

Claims 1-42 and 45-60 are currently pending in the application, with claims 1, 17, 18, 26, 42, 45 and 53 being independent. Applicants respectfully request entry of this amendment and favorable consideration in light of the comments contained herein, and earnestly seek timely allowance of the pending claims.

Impropriety of Finality of Office Action

In the outstanding Final Office Action, the Examiner indicated a new ground of rejection was applied for claims 1-42 and 45-60, and that Applicant's amendment necessitated the new grounds of rejection. (See Office Action, page 10, para. no. 7.)

The Examiner is respectfully reminded of the provisions M.P.E.P. §706.07(a):

[f]urthermore, a second or any subsequent action on the merits in any application ... will not be made final if it includes a rejection on newly cited art ... of any claim not amended by applicant ... in spite of the fact that other claims may have been amended to require newly cited art.

Applicants note that independent claim 42 was not amended in the last reply, making the finality of the Office Action improper. Accordingly, Applicants respectfully request the Examiner to withdraw the finality of the Office Action.

Claims Rejections Under 35 U.S.C. §102

The Examiner maintained the rejection of claims 1-42, 45-46, 49-54, and 57-60 under 35 USC §102(e) as being anticipated by USP 6,345,304 B1 to Dymetman et al. ("Dymetman"). Applicants submit the Examiner has failed to establish a *prima facie* case of anticipation and traverse the rejection.

Regarding claims 1, 17, 18, 26, and 42, in the Final Office Action, the Examiner made a number of interpretations of the Dymetman references for which Applicants respectfully disagree.

For example, the Examiner asserted that the feature “imaginary surface is now being interpreted as marking substrate (108) of Dymetman.” (See Office Action: page 10, para. no. 7.) Applicants submit this is not a reasonable interpretation of the Dymetman reference, and thus cannot be used as the basis for properly anticipating independent claims 1, 17, 18, 26, and 42.

Dymetman discloses that coded substrate 106 in turn comprises a layer 108 of visible or invisible machine readable markings printed on a sheet medium 110 (e.g. paper) (col. 6, lines 4-7; Figs. 1 and 2). Dymetman explicitly defined that the substrate is a **physical medium** on which a pattern of marks can be produced, such as by marking or printing actions. Common examples of marking substrates include sheets of paper and plastic (col. 5, lines 59-62).

Because substrate 106 comprises layer 108, and substrate 106 is a physical medium, there is no reasonable basis for interpreting layer 108 as an “imaginary surface.” As provided in the specification for one embodiment of the invention, the imaginary surface is imaginary “in so much as it is never present in its entirety on a base or product.” (See Specification: pages 9-10, bridging paragraph.)

Moreover, the information encoded in the cell 202 does not provide information “to which region on the imaginary surface the at least one position belongs”, as asserted by the Examiner, but merely provides information regarding one position on the substrate (see example disclosed in col. 6, lines 32-33).

Accordingly, Applicants maintain that Dymetman fails to disclose, at least, “user units... arranged to record information which comprises at least one position on the imaginary surface,” as recited in claims 1 and 17, and, at least, a “user unit [that] records the information in such a way that

comprises at least one position on at least one imaginary surface,” as recited in claim 26, and, at least, “receipt of information which contains at least one position on an imaginary surface,” as recited in claims 18 and 42.

Applicants therefore respectfully request the Examiner to withdraw the rejections of claims 1, 17, 18, 26, and 42. Claims 2-16 depend from allowable claim 1, and are allowable by virtue of their dependency. Claims 19-25 depend from allowable claim 18 and thus are allowable by virtue of their dependency. Claims 27-41 depend from allowable claim 26 and are allowable by virtue of their dependency.

Regarding independent claims 45 and 53, Dymetman merely discloses an embodiment which may relate to techniques for obtaining network addresses from identifiers. The identifier, which could be a page identifier, may indicate a value that identifies an action that can be produced through a network. (See column 2, lines 9-16.)

In Figure 7, Dymetman illustrates a table that can be stored in memory a central router. Table 704 may store group data 706 indicating groups of consecutive PIDs and network address data 708, with the two types of data being related in table entries, such that Table 704 can be accessed using a PID in any of the groups to obtain a particular group’s associated network address (Column 7, lines 57-61).

Conversely, Dymetman fails to disclose, at least, “identifying which region the at least one position belongs in response to the receipt of the information,” as recited in claim 45; and “identifies a region on the two-dimensional coordinate reference based upon the at least one position,” as recited in claim 53.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 45 and 53, and any claims depending therefrom.

Claims Rejections Under 35 U.S.C. §103

The Examiner rejected claims 47-48 and 55-56 under 35 U.S.C. §103(a) as being unpatentable over Dymetman in view of U.S. Pat. No. 5,449,896 to Hecht et al. ("Hecht"). Applicants submit the Examiner has failed to establish of *prima facie* case of obviousness and respectfully traverse the rejection.

Claims 47-48 depend from independent claim 45, and claims 55-56 depend from independent claim 53. Dependent claims include all of the features recited in the respective independent claims from which they depend, and are allowable at least for the reasons provided above for allowable claims 45 and 53.

Hecht fails to cure the deficiencies of Dymetman as provided above.

Hecht merely discloses an optically readable record for storing encoded information using a self-clocking data code for encoding the information, with this data code being composed of glyphs that are written in a two dimensional code on centers that are spatially distributed in nominal accordance with a predetermined spatial formatting rule.

Accordingly, Applicants respectfully request the Examiner to withdraw the §103 rejection of claims 47-48 and 55-56.

CONCLUSION

In view of the above remarks, this application appears to be in condition for allowance and the Examiner is, therefore, requested to reexamine the application and pass the claims to issue.

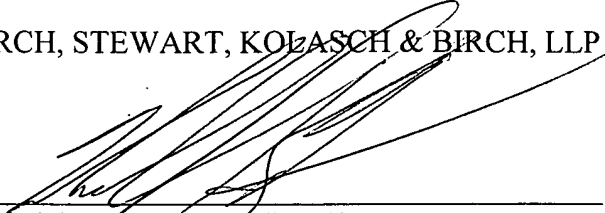
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael K. Mutter (Reg. No. 29,680) at the telephone number of the undersigned below.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By


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